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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR   | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|------------------------|---------------------|------------------|
| 10/532,740   | 04/26/2005  | Pieter Johan Peeters   | PRD-2008-USPCT1     | 3700             |
| 27777 7590 06/25/2008<br>PHILIP S. JOHNSON<br>JOHNSON & JOHNSON<br>ONE JOHNSON & JOHNSON PLAZA<br>NEW BRUNSWICK, NJ 08933-7003 |             |                        |                     |                  |
| EXAMINER<br>SAOUD, CHRISTINE J   |             |                        |                     |                  |
| ART UNIT<br>1647   |             | PAPER NUMBER           |                     |                  |
| MAIL DATE<br>06/25/2008  |             | DELIVERY MODE<br>PAPER |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/532,740

## Applicant(s)

PEETERS ET AL.

## Examiner

Christine J. Saoud

## Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 11-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date 04/26/05, 10/02/06
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### ***Election/Restrictions***

Applicant's election of Group I, claims 1-4 and 6-10 in the reply filed on 07 February 2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 5 and 11-34 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 07 February 2008.

### ***Specification***

The amendment filed 22 February 2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the statement "each of which is hereby incorporated by reference" is new matter because it was not filed at the same time as the application.

Applicant is required to cancel the new matter in the reply to this Office Action.

The specification is objected to because of the following informalities:

The specification does not use the appropriate format for referencing a sequence identifier. The proper format is "SEQ ID NO:X", wherein "X" is the number of the sequence identifier. Appropriate correction is required.

### ***Drawings***

The drawings are objected to because:

- 1) Tables should not be contained in the drawings because they are not Figures.

The tables should be found in the body of the Specification. Appropriate correction is required.

2) 37 CFR § 1.84 (U)(1) states that when partial views of a drawing which are intended to form one complete view, whether contained on one or several sheets, must be identified by the same number followed by a capital letter. For example, the drawings which are labeled Figure 4 and Figure 4 continued in the instant specification should be renumbered as Figures 4A -4D. Additionally, Figure 5 contains 3 panels and should be Figures 5A-5C. Applicant is reminded that once the drawings are changed to meet the separate numbering requirement of 37 CFR § 1.84 (U)(1), the Brief Description of the Drawings and the rest of the specification must be corrected accordingly.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate

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changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

Claims 1, 3, 4, 5, 8 and 10 are objected to because of the following informalities: the claims do not use the appropriate format for referencing a sequence identifier. The proper format is "SEQ ID NO:X", wherein "X" is the number of the sequence identifier. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Ma et al.

Ma et al. (US Pub. 2003/0171253 A1) teach a nucleic acid molecule which has 100% nucleic acid sequence identity to SEQ ID NO:47. Because the sequence is 100% identical, it would inherently encode the protein recited in the claims, including a protein with the recited activity. Therefore, Ma et al. anticipates claims 1-4.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Strausberg et al.

Strausberg et al. (GENEMBL accession no. BC005546) teach a nucleic acid molecule which has 100% nucleic acid sequence identity to SEQ ID NO:45. Because the sequence is 100% identical, it would inherently encode the protein recited in the claims, including a protein with the recited activity. Therefore, Strausberg et al. anticipates claims 1-4.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 and 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ma et al. or Strausberg et al..

The disclosures of Ma et al. and Strausberg et al. are as described above. Neither reference teaches vectors and host cells expressing encoded protein. However, it would have been prima facie obvious to one of ordinary skill in the art at the time of the instant invention to insert the nucleic acid molecules of either Ma et al. or Strausberg et al. into a vector and a host cell in order to recombinantly produce the protein encoded by the nucleic acids. One would be motivated to put the nucleic acid molecules into a vector and recombinantly produce the encoded proteins, including using regulatory sequences, because this is routine in the art for further elucidating the significance of the nucleic acid molecules which were taught by Ma et al. and Strausberg et al. One would have a reasonable expectation of success in doing this because at the time the invention was made, the recombinant production of proteins was old and well known in the art. Therefore, the invention as a whole would have been prima facie obvious at the time it was made, absent evidence to the contrary.

### ***Conclusion***

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine J. Saoud whose telephone number is 571-272-0891. The examiner can normally be reached on Monday-Friday, 6AM-2PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Manjunath Rao can be reached on 571-272-0939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christine J Saoud/  
Primary Examiner, Art Unit 1647